

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

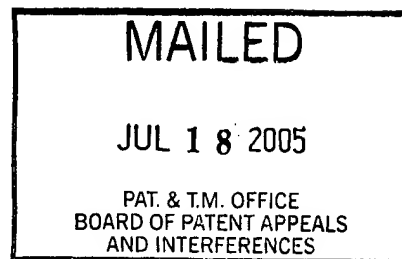
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID SUDA, LARRY CLEVENSTINE and BRUCE ROFSKY

Appeal No. 2005-1301
Application No. 09/584,182

ON BRIEF



Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 8, all of the claims remaining in the application. Claims 2 and 9 through 19 have been cancelled.

Appellants' invention relates to a bagging apparatus and method for inserting a rolled item into a receptacle, such as a flexible sleeve or bag, for storage and shipping. See, for example, Figures 1 through 4 of the application drawings, wherein Figures 1-3

show the bagging apparatus (10) with a receptacle or bag (70) fit over an exterior surface of a tube section (22) of the apparatus, and Figures 4A-4D show a method of bagging a rolled item (12). In the paragraph bridging pages 7 and 8 of the specification, it is indicated that

[p]referably the rolled sheet of material 12 is inserted within the flared section while rotating the sheet of material 12 in a clockwise direction as viewed in Figure 4B. By rotating the rolled sheet of material 12 in a direction opposite the direction that rolled sheet of material is rolled, the terminal edge 16 of the rolled sheet of material 12 is maintained flat against the exterior surface of the rolled sheet of material 12. By using this method, the final product will be aesthetically pleasing to a consumer, since the rolled sheet of material 12 will be neatly inserted into the receptacle 70 without any frayed or deformed edges.

Independent claims 1, 3 and 4 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

| | | |
|---|------------|---------------|
| Buchman et al. (Buchman) | 5,020,302 | Jun. 4, 1991 |
| Robinson ¹ (British Patent Specification) | GB 448,519 | Jun. 10, 1936 |

¹Although the inventors in this reference are indicated to be Charles Webley and Kenneth Davies, we note that the examiner has consistently referred to it by the name of the assignee, Robinson Limited. For the sake of clarity, we will continue to do so.

Claims 1 and 3 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Buchman.

Rather than reiterate the examiner's statement of the above-noted rejection and the conflicting viewpoints advanced by appellants and the examiner regarding the rejection, we refer to examiner's answer (mailed May 17, 2004) for the reasoning in support of the rejection and to the brief (filed April 7, 2004) and reply brief (filed July 19, 2004) for appellants' arguments to the contrary.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art references, and the respective positions advanced by appellants and the examiner. As a consequence of our review, we have made the determination that the evidence relied upon by the examiner is not sufficient to support a conclusion of obviousness under 35 U.S.C. § 103 with respect to appellants' claims 1 and 3 through 8 on appeal. Our reasoning for this determination follows.

Like the examiner, we note that Robinson discloses a bagging apparatus and method for inserting a rolled item into a receptacle, such as a flexible sleeve or bag (page 1, lines 23-38). The method used in Robinson is essentially the same as appellants' method as defined in the claims on appeal, except that there is no disclosure or teaching of rotating the item as it is inserted within the flared section (5) of the apparatus, or as it is slid through the cylindrical tube section of the apparatus, as is required in appellants' claims on appeal. The disclosure of Robinson teaches using a ram like that seen in Figure 5 of the drawings to push the rolled item through the bagging apparatus (page 1, line 102 - page 2, line 4).

To account for this difference, the examiner turns to Buchman, urging that it teaches rotating a rolled item in a roll inserter wherein the rolled item is rotated in a direction opposite the direction of the roll from the center of the spiraling outward during an insertion operation. The examiner directs our attention to Figure 1 and the disclosure at column 3, lines 57-60 of Buchman. Based on this teaching, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention "to include the rotating of a rolled product as taught by Buchman et al. in the invention of Robinson et al. in order to assist in the insertion process" (answer, page 4).

Like appellants, we see no basis to be fairly derived from a collective evaluation of the teachings of the very different methods and apparatus of Robinson and Buchman which would have led one of ordinary skill in the art at the time of appellants' invention to utilize rotation of a rolled article as taught in Buchman in the bagging apparatus of Robinson. In our view, the examiner's proposed modification of the apparatus and method of Robinson is based on impermissible hindsight derived from first having read appellants' disclosure and claims. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

As explained on page 2, lines 100-110, of Robinson, the method therein addresses packing of mattresses, quilts, rugs or like compressible and coilable articles in bags or tubular containers and comprises

rolling the article into coiled form, inserting the coiled article into one end of a tube to retain its coiled form and pushing the article through the tube into the bag or container, located over the other end of the tube, in which the article is free to expand radially.

Thus, Robinson clearly relies on insertion of the rolled item into the tube of the guiding device to retain its coiled form.

By contrast, there is no guide structure or apparatus shown or used in Buchman for confining and holding the roll of bags (140) and tail (142) thereof, thus the finger body (132) and roll inserter spindle (122) must include a rotating means (126) for rotating the spindle and the roll of bags in a direction to wind up the tail (142) of the bag roll while the spindle is retracted and before the roll of bags is pulled into the open-ended carton (150).

Given the clearly disparate structures and methods involved in Robinson and Buchman, we see no reason or suggestion for incorporating the rotation of the rolled bags as taught in Buchman in the type of guided bagging apparatus seen in Robinson. Thus, since we have determined that the teachings and suggestions found in Robinson and Buchman would not have made the subject matter as a whole of independent claims 1, 3 and 4 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103. It follows that the examiner's rejection of dependent claims 5 through 8 under 35 U.S.C. § 103(a) based on the teachings of Robinson and Buchman will likewise not be sustained.

As noted by appellants in their reply brief, the examiner's unsubstantiated comments on page 4 of the answer regarding what is purportedly well known in the art,

and the further mention of the patents to Chapuis and Holt on page 5 of the answer, are to no avail, since, in the first instance the examiner has proffered no prior art to substantiate what is urged to be well known in the prior art, and in the second instance has not premised a rejection on the patents to Chapuis and Holt.

In light of the foregoing, the decision of the examiner rejecting claims 1 and 3 through 8 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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